

## **REMARKS/ARGUMENTS**

### **1. Claim Amendments**

The Applicant has amended claims 1, 23, 24, 28 and 32. Applicant respectfully submits no new matter has been added. Support for the substantive additions can be found at least in Figure 2a and in the description thereof. Accordingly, claims 18-19, 21-24, 26-29 and 31-34 are pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

### **2. Claim Rejections – 35 U.S.C. § 102(e)**

Claims 18-19, 21-24, 26-29, and 31-34 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Sylvain (US 7,366,183). As amended, Applicant respectfully submits that Sylvain fails to disclose all the elements of independent claims 18, 23 and 28 of the present invention. In *Net Money In v. Verisign* (Fed. Cir. 2008), the Federal Circuit held that anticipation takes more than simply locating each element within the four corners of a single document. To anticipate, the prior art must teach all the claim elements and the claimed arrangement. Section 102 embodies the concept of novelty—if a device or process has been previously invented (and disclosed to the public), then it is not new, and therefore the claimed invention is "anticipated" by the prior invention. . . . Because the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements "arranged as in the claim." Focusing for a moment on arrangement – to anticipate, the reference must teach "all of the limitations arranged or combined in the same way as recited in the claim."

The Examiner states that Sylvain (US 7,366,183) discloses two communication systems (fig 1 - a CS network 12 and a PS network 26) automatically discover whether a packet data channel can be established between a caller and a called party by the two

communication systems for transfer of media in parallel with the voice call (col. 9, lines 31-35). Applicant notes that Sylvain describes how two different devices held by the same user—one a telephony device, the other being, e.g., a PDA or computer (See Figs. 1 and 5, elements 16 and 22), can be associated with two similar devices (See Fig. 1, corresponding elements 16 and 22), or a single device, held by a different user (See Fig. 5, element 34). Notably, in Sylvain, one of such pairs must be part of a wire-line network. Hence, in Sylvain requires either two (2) pair of devices (4 total) or one pair of devices and a single device (3 total), one of which terminates in a wire-line network, to perform its invention while the present invention uses two (2) terminals/devices each such terminal terminating over a wireless network.

The elements of claim 18 are presented below. The provisions of Sylvain cited by the Examiner are thereafter set forth:

*Method for automatically discovering a shared multimedia service capability of two user equipments each of which terminate in a wireless communications network when initiating a voice call between two parties, one of the user's equipment, which belongs to a calling party being capable of running simultaneously both a circuit switched voice call in a CS network, and a packet switched IP session supported by a PS network, and at least one second user equipment, belonging to a called party, which multimedia capability may be unknown to the calling party and for discovering matching multimedia capability of the two user equipments when initiating a voice call over the circuit switched network to the other user equipment:*

Sylvain, Col. 1, line 50 - col. 2, line 12:

The present invention allows a terminating telephony switch to detect whether or not a caller associated with an incoming call is associated with multimedia capability. The terminating telephony switch will monitor a call setup message, such as an Integrated Services User

Protocol (ISUP) Initial Address Message (IAM), to determine whether or not there is multimedia capability information indicative of the caller's telephony terminal being associated with another media device, or including media capability sufficient to support packet sessions over a data network. The multimedia capability information may simply be the presence or absence of a flag, wherein the presence of a flag indicates there is multimedia capability. Alternatively, the call setup message may include the multimedia address associated with the media device of the caller. The originating telephony switch is configured to create call setup messages to provide multimedia capability information to enable the functionality of the terminating telephony switch.

Both the originating and terminating telephony switches may interact with a service node to obtain multimedia client addresses for the caller or called party based on directory numbers provided in call signaling. The service node may initiate messaging sessions with the respective multimedia clients, and in particular, is effective in sending the multimedia address for a first multimedia client to that of a second multimedia client, such that the second multimedia client can communicate with the first multimedia client. In essence, the service node helps to facilitate either the caller or called party's multimedia client obtaining the multimedia address for the other party's multimedia client.

Nowhere therein is there disclosed two (2) user equipments, each of which terminate in a wireless network, being capable of running simultaneously both a circuit switched voice call in a CS network, and a packet switched IP session supported by a PS network. Hence, there necessarily cannot be disclosed the remaining elements of claims 18, 23 and 28.

Sylvain, Col. 4, lines 15-39 provides:

In general, the present invention allows the terminating telephony switch 14, the telephony switch supporting the called party, to determine whether the caller is associated with multimedia capabilities based on information provided in call setup messages. In one embodiment, the call setup messages are Integrated Services User Protocol (ISUP) Initial Address Messages (IAMS). If the called party is associated with multimedia capabilities, the ISUP IAMS may include a message, such as a flag, indicative of the presence of an associated multimedia client 22, the address on the data network 26 for the multimedia client 22, or a

combination thereof. Importantly, the messages may take virtually any form that the terminating telephony switch 14 can use to determine whether the caller is associated with multimedia capabilities. The information provided with the ISUP IAM may indicate that there is no multimedia capability, or the ISUP IAM may not have any additional information, which the terminating telephony switch 14 will use to determine that there is no multimedia capability associated with the caller. Again, the caller is associated with multimedia capabilities if the caller's telephony terminal 16 is associated with a multimedia client 22 as described above, or if the caller is associated with a combined device having both voice and media capabilities, as will be described in FIG. 5.

Again, nowhere is there disclosed therein the use of a single user equipment on each terminating end of a wireless network being capable of running simultaneously both a circuit switched voice call in a CS network, and a packet switched IP session supported by a PS network. Sylvain requires that there be at least one terminating end in a wire-line network, and there at least be a telephony device and a media device at one terminating end. Sylvain, Col. 3, lines 49-59 provides:

During multimedia sessions including voice and data sessions between the associated clients 24, the data sessions are facilitated between the multimedia clients 22 over a data network 26 using corresponding data access networks 28. In the wireless environment, the data access network 28 will interface with the base stations 20 to facilitate communications with the illustrated multimedia client 22B, which is a personal digital assistant with wireless capability. The voice session is established via a telephony call between the telephony devices 16.

The foregoing only discloses the data sessions by the media devices. It does not disclose a single user terminal at each terminating end of a wireless network being capable of running simultaneously both a circuit switched voice call in a CS network, and a packet switched IP session supported by a PS network. Claim 18 further claims:

*Receiving from means in the CS network simultaneously a capability request for the two user equipments to the PS network supporting the SMM service*

Sylvain, Col. 2, line 57 to col. 3, line 2 provided by the Examiner in response thereto, states:

The present invention enables a traditional telephony switch for either wireline or wireless applications to more efficiently operate in a multimedia environment, wherein voice sessions through the traditional telephony network are associated with one or more media sessions facilitated through a data network. In general, the telephony switches supporting the communicating users' telephony devices need to determine whether the respective parties have media capabilities, which can be associated with a particular voice session or call. With the present invention, the call processing information exchanged during call setup provides for the originating telephony switch to indicate that the caller has multimedia capabilities.

The foregoing does not disclose a single user terminal at each terminating end of a wireless network being capable of running simultaneously both a circuit switched voice call in a CS network, and a packet switched IP session supported by a PS network. Sylvain expressly requires that one terminating end be a wire-line network having a telephony device and a separate media device.

Claim 18 further claims:

*Responding simultaneously to the user equipments information regarding matching multimedia capability*

The Examiner points to Sylvain, Col. 3, lines 11-15:,

If both the caller and called party have multimedia capabilities, the terminating switch will take the necessary steps to facilitate a media session between multimedia clients associated with the caller and called party.

As noted above, Sylvain requires the use of a telephony device and media device on at least one of the terminating ends, which terminating end is a wire-line network. The present invention requires a single user equipment on each terminating



end of a wireless network. In light of the foregoing amendments and remarks, the allowance of claims 18-19, 21-24, 26-29 and 31-34 is respectfully requested.

### **CONCLUSION**

In view of the foregoing remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for all pending claims.

The Applicant requests a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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